

01/30/04

HDP/SB/21 based on PTO/SB/21 (08-00)

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TRANSMITTAL FORM

to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	10/678,052
Filing Date	9-30-2003
First Named Inventor	Mark Bass et al.
Group Art Unit	3746
Examiner Name	Unknown
Attorney Docket Number	0315-000414/REF

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input checked="" type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Form HDP-1449 with references cited (4 Foreign Patent Documents and 3 Other Documents); and Acknowledgment Postcard
Remarks		The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 08-0750. A duplicate copy of this sheet is enclosed.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name Michael Malinzak	Reg. No. 43,770
Signature			
Date	January 29, 2004		

CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as express mail in an envelope addressed to: Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below.

Typed or printed name	Michael Malinzak	Express Mail Label No.	EV 406 075 895 US (1/29/2004)
Signature		Date	January 29, 2004

EV 406 075 895 US



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/678,052
Filing Date: 9-30-2003
Applicant: Mark Bass et al.
Group Art Unit: 3746
Examiner: Unknown
Title: CAPACITY MODULATED SCROLL MACHINE
Attorney Docket: 0315-000414/REF

Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Sir:

Pursuant to 37 C.F.R. §§ 1.56, 1.97 and 1.98, Applicant hereby submits an Information Disclosure Statement for consideration by the Examiner.

I. **LIST OF PATENTS, PUBLICATIONS, AND OTHER INFORMATION**

The patents, publications and other information requested to be considered by the Office (except unpublished U.S. patent applications) are listed on Form 1449 attached hereto.

II. **COPIES**

A. Submitted herewith is a legible copy of (i) each U.S. patent application publication and U.S. and foreign patent; (ii) each publication or that portion which caused it to be listed; (iii) for each cited pending U.S. application, the application specification including the claims, and any drawing of the application which caused it to be listed including the claims directed to that portion; and (iv) all other information or that portion which caused it to be listed.

B. X Any patents, publications or other information which are listed on Form 1449 or on the copies of PTO-892, but which are not enclosed herewith, were previously cited by or submitted to the PTO in one of the following applications which has been relied upon for an earlier filing date under 35 U.S.C. § 120:

U.S. Serial Number
08/486,118
08/479,025
08/479,026
08/967,851
10/184,227

U.S. Filing Date
6-7-95
6-7-95
6-7-95
11-12-97
8-27-02

C. X Because the present application was/is being filed after June 30, 2003, no copies of the U.S. patents or U.S. patent application publications which are listed on the attached Form 1449 are enclosed pursuant to the waiver of 37 C.F.R. § 1.98(a)(2)(i). Any foreign patent documents or non-patent literature listed on the attached Form 1449 are enclosed herewith.

D. _____ This is a PCT application in the entry of the National Phase in the United States. A copy of the International Search Report is attached for the Examiner's information. The documents listed on the International Search Report are listed on the attached Form-1449 for consideration by the Examiner and for listing on any patent resulting from this application. Since the International Search Report was from the US, EPO, or JPO search authorities, copies of these references should have been supplied to the USPTO under the trilateral agreement and are believed to be in the file of the above-identified application. (MPEP 1893.03(g))

III. CONCISE EXPLANATION OF THE RELEVANCE (check at least one box)

A. X Except as may be indicated below in (B), all of the patents, publications or other information are in the English language (concise explanation not required).

B. X A concise explanation of the relevance of each patent, publication or other information listed that is not in the English language is as follows (see 37 C.F.R. § 1.98(a)(3)):

1. _____ See the attached foreign patent office communication from a counterpart foreign application:
2. _____ English translations are provided:
3. X Other: **English language Abstracts are provided for:
DE 3422398A and EP 0 351 690 A1.**

C. X The following additional information is provided for the Examiner's consideration. **A copy of the European Search Report is attached for the Examiner's information.**

IV. CROSS REFERENCE TO RELATED APPLICATION(S)

A. X The Examiner is advised that the following co-pending application(s) contain(s) subject matter that may be related to the present application. By bringing this(these) application(s) to the Examiner's attention, Applicant(s) does(do) not waive the confidentiality provisions of 35 U.S.C. § 122.

Serial No.
10/184,227

Filing Date
6-27-2002

Art Unit
3746

V. THIS IDS IS BEING FILED UNDER

A. X **37 C.F.R. § 1.97(b):** (check only one box)

1. ____ within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d) (37 C.F.R. § 1.97(b)(1)). No fee or certification is required.

2. ____ within three months of the date of entry of the national stage as set forth in §1.491 in an international application (37 C.F.R. § 1.97(b)(2)). No fee or certification is required.

3. X before the mailing of a first Office Action on the merits (37 C.F.R. § 1.97(b)(3)). (No fee or certification is required.) In the event that a first Office Action on the merits has been issued, please consider this IDS under 37 C.F.R. § 1.97(c) and see the certification under 37 C.F.R. § 1.97(e) below; or, if no certification has been made, charge our deposit account a fee in the amount of \$180.00 as required by 37 C.F.R. § 1.17(p).

4. ____ before the mailing of a first Office Action after the filing of a request for continued examination under 37 C.F.R. § 1.114. No fee or certification is required.

B. X **37 C.F.R. § 1.97(c):** (check only one box)

before the mailing date of either any Final Office Action under 37 C.F.R. § 1.113, a Notice of Allowance under 37 C.F.R. § 1.311, or an action that otherwise closes prosecution.

1. X No certification; therefore, a fee in the amount of \$180.00 is required by 37 C.F.R. § 1.17(p).

2. ____ See the certification below. No fee is required.

C. ____ **37 C.F.R. § 1.97(d):**

after the mailing date of either a Final Office Action under 37 C.F.R. § 1.113 or a Notice of Allowance under 37 C.F.R. § 1.311, yet on or before payment of the issue fee.

1. ____ See the certification below. A fee in the amount of \$180.00 is required by 37 C.F.R. § 1.17(p).

VI. CERTIFICATION UNDER 37 C.F.R. § 1.97(e): (check only one box)

The undersigned hereby certifies that:

A. ____ each item of information contained in this IDS was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS (See 37 C.F.R. § 1.97(e)(1)). See further statement under 37 C.F. R. 1.704(d) below in section VII, if applicable; or

B. ____ no item of information contained in this IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in this IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this IDS (See 37 C.F.R. § 1.97(e)(2)).

C. ____ Some of the items of information were first cited in a communication from a foreign patent office. As to this information, the undersigned hereby certifies that each item of information contained in this IDS was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS. As to the remaining information, the undersigned hereby certifies that no item of this remaining information contained in this IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in this IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this IDS.

VII. STATEMENT UNDER 37 CFR 1.704(d)

The undersigned hereby states that:

____ each item of information contained in this IDS was cited in a communication from a foreign patent office in a counterpart application and this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this IDS.

VIII. PAYMENT OF FEES (check only one box)

A. ____ A check in the amount of \$180.00 is enclosed for the above-identified fee.

B. ____ Please charge Deposit Account No. 08-0750 in the amount of \$180.00 for the above-indicated fee. A duplicate copy of this paper is attached.

The above references are being cited only in the interest of candor and without any admission that they constitute statutory prior art, contain matter which anticipates the invention, or which would render the same obvious, either singly or in combination, to a person of ordinary skill in the art. Furthermore, this Information Disclosure Statement shall not be construed as a representation that a search has been made.

If it is determined that this IDS has been filed under the wrong rule, the PTO is requested to consider this IDS under the proper rule (with a petition if necessary) and charge the appropriate fee to Deposit Account No. 08-0750.

Please charge any additional fees or credit any overpayment pursuant to 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 08-0750.

Respectfully submitted,

Dated: Jan 29, 2003

By: 
Michael Malinzak, Reg. No. 43,770

HARNESS, DICKEY & PIERCE, P.L.C.
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Bloomfield Hills, Michigan 48303
(248) 641-1600

MM/ca

FORM HDP-1449 (Based on Form PTO-1449)

ATTORNEY DOCKET NO.

SERIAL NO.

0315-000414/REF

10/678,052

PATENT AND TRADEMARK OFFICE

OIP INFORMATION DISCLOSURE CITATION

(Use several sheets if necessary)

APPLICANT

Mark Bass et al.

FILING DATE

GROUP

9-30-2003

3746

Sheet 1 of 2

U.S. PATENT DOCUMENTS

Ref. Desig.	Examiner's Initials	Document Number	Date	Name	Class/ Subclass	(If appropriate) Filing Date
1.		4,505,651	3/1985	Terauchi et al.		
2.		4,575,318	3/1986	Blain		
3.		4,604,036	8/1986	Sutou et al.		
4.		4,610,610	9/1986	Blain		
5.		4,744,733	5/1988	Terauchi et al.		
6.		4,747,756	5/1988	Sato et al.		
7.		4,764,096	8/1988	Sawai et al.		
8.		4,774,816	10/1988	Uchikawa et al.		
9.		4,846,633	7/1989	Suzuki et al.		
10.		5,059,098	10/1991	Suzuki et al.		
11.		5,263,822	11/1993	Fujio		
12.		5,277,563	1/1994	Weu-Jeu et al.		
13.		5,282,728	2/1994	Swain		
14.		5,282,729	2/1994	Swain		
15.		5,290,161	3/1994	Swain		
16.		5,336,058	8/1994	Yokoyama		
17.		5,342,185	8/1994	Anderson		
18.		5,342,186	8/1994	Swain		
19.		5,366,359	11/1994	Bookbinder et al.		
20.		5,366,360	11/1994	Bookbinder et al.		
21.		5,411,384	5/1995	Bass et al.		

Examiner:

Date Considered:

EXAMINER: Please initial if citation considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

FORM HDP-1449 (Based on Form PTO-1449)

ATTORNEY DOCKET NO.

SERIAL NO.

0315-000414/REF

10/678,052

APPLICANT

Mark Bass et al.

FILING DATE

GROUP

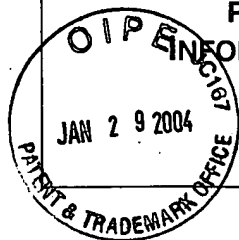
9-30-2003

3746

PATENT AND TRADEMARK OFFICE
INFORMATION DISCLOSURE CITATION

(Use several sheets if necessary)

Sheet 2 of 2



U.S. PATENT DOCUMENTS

Ref. Desig.	Examiner's Initials	Document Number	Date	Name	Class/ Subclass	(If appropriate) Filing Date
22.		5,435,707	7/1995	Hirano et al.		
23.		5,447,420	9/1995	Caillat et al.		
24.		5,520,527	5/1996	Kim		
25.		5,531,577	7/1996	Hayashe et al.		

FOREIGN PATENT DOCUMENTS

Ref. Desig.	Examiner's Initials	Document Number	Date	Country	Class/ Subclass	Translation Yes	No
1.		DE 34 22 398 A	19.12.1985	Germany			
2.		WO 86 01262 A	27.02.1986	PCT			
3.		EP 0 351 690 A1	24.01.1990	EPO			
4.		EP 0 557 023 A1	25.08.93	EPO			

OTHER DOCUMENTS (including Author, Title, Date, Pertinent Pages, etc.)

Ref. Desig.	Examiner's Initials	
1.		European Search Report for Application No. EP 95 30 7811; 1 December 1998; 3 Pages.
2.		English-language Abstract and English-language Summary for Japanese Application No. 59-117895; 8/1984; 5 Pages.
3.		English-language Abstract for Japanese Publication No. 61046485; 06-03-86; 1 Page.

Examiner:

Date Considered:

EXAMINER: Please initial if citation considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.